

REMARKS

Claims 1, 119-122, 124-125, 127-129 and 131-134 are pending in the application. Implicit support for “intact” in claims 1 and 132 can be found throughout the specification. The amendment is made to make explicit subject matter which is implied in the application, that the oligonucleotide that is immobilized on a surface is a pre-made molecule, which is not “grown” on the surface. No new matter has been added to the specification.

Objection Under 37 C.F.R. 1.75(c)

Claim 131 has been objected to under 37 C.F.R. 1.75(c) as being of improper form. Claim 131 has been amended to conform to the rules. Therefore, this objection has been overcome.

Rejection Under 35 USC § 102(b) Over Bamdad (WO 98/31839)

Claims 1, 131 and 132 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Bamdad (WO 98/31839). Applicant traverses this rejection. Reconsideration and withdrawal thereof are respectfully requested.

Bamdad ‘839 discloses a technique for immobilizing biological molecules, such as nucleic acid molecules. However, Bamdad ‘839 fails to disclose or suggest a biological assay system in which the immobilized oligonucleotide identifier is separated from the surface in order to be identified. Therefore, Bamdad ‘839 fails to anticipate the claimed invention.

Rejection Under 35 USC § 102(e) Over Bamdad (US Patent 6,541,617)

Claims 1, 119-122, 127-129 and 131-132 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Bamdad (US Patent 6,541,617). Applicant traverses this rejection.

Reconsideration and withdrawal thereof are respectfully requested.

Bamdad '617 discloses use of particles which use ligands and electron transfer moieties. However, Bamdad '617 fails to disclose or suggest a biological assay system in which the immobilized oligonucleotide identifier is separated from the surface in order to be identified. Therefore, Bamdad '839 fails to anticipate the claimed invention.

Rejection Under 35 USC § 102(b) Over Dower (US Patent 5,639,603)

Claims 1, 119-120, 123, 125, 127-129 and 131-132 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Bamdad (US Patent 6,541,617). Applicant traverses this rejection. Reconsideration and withdrawal thereof are respectfully requested.

Dower '603 discloses a library of small molecules built on a solid support, wherein each step of the synthesis is tracked by building up a nucleic acid in parallel with the synthesis of the small molecule. In contrast, the presently claimed invention is directed to attaching an "intact" or pre-made oligonucleotide identifier to a surface to which a peptide, protein or other potential binding partner is also attached. Therefore, Dower '603 fails to anticipate the presently claimed invention.

**Rejection Under 35 U.S.C. §103(a) Over Dower (US Patent 5,639,603) In View Of
Bamdad (WO 98/31839)**

Claims 121-122 and 124 have been rejected under 35 U.S.C. §103(a) as being "obvious" over Dower '603 in view of Bamdad '839. Applicant traverses this rejection. Reconsideration and withdrawal thereof are respectfully requested.

Dower '603 and Bamdad '839 are discussed above.

Since Dower '603 fails to be relevant to the base claims 1 and 132, and Bamdad '839 fails to remedy the deficiency of the Dower '603 reference as discussed above, it is believed that the combination of the Dower '603 and Bamdad '839 also fails to result in the claimed invention as applied to claims 121-122 and 124. Accordingly, the presently claimed invention is patentable over the cited references.

Conclusion

It is believed that the application is now in condition for allowance. Applicants request the Examiner to issue a notice of Allowance in due course. The Examiner is encouraged to contact the undersigned to further the prosecution of the present invention.

The Commissioner is authorized to charge JHK Law's Deposit Account No. **502486** for any fees required under 37 CFR § 1.16 and 1.17 and to credit any overpayment to said Deposit Account No. **502486**.

Respectfully submitted,

JHK Law

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